

Notice of Allowability

Application No.

09/893,938

Examiner

Callie E. Shosho

Applicant(s)

BOTROS ET AL

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to amendment filed 6/20/05.
2. ☒ The allowed claim(s) is/are 1,5,8,9,12,13 and 17-19.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying Indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date _____
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

Statement of Reasons for Allowance

1. The present claims are allowable over the “closest” prior art Botros ‘512 (U.S. 6,280,512), Botros ‘789 (U.S. 5,730,789), and Bates et al. (U.S. 5,958,999) for the following reasons:

Botros ‘512 discloses ink comprising 3% dimethylaminoethanol, 1.6% ethoxylated polyethyleneimine, 0.6% ammonium sulfate, 0.05% surfactant, and 0.1% biocide as well as lower aliphatic alcohol.

However, as set forth in amended 35 USC 103(c), subject matter which qualifies as prior art under one or more subsections (e), (f), and (g) of section 102 cannot be applied against the claimed invention if the prior art and the claimed invention “were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.” This rule change to 103(c) applies to any patent application filed on or after November 29, 1999. See Official Gazette, April 11, 2000. As noted in the Official Gazette, the “mere filing of a continuation application on or after November 29, 1999 will serve to exclude commonly owned 102(e) prior art that was applied, or could have been applied, in a rejection under 103 in the parent application.”

Given that the filing date of the present application is subsequent to November 29, 1999, that Botros ‘512 qualifies as prior art under 102(e) and was utilized in rejections under 35 USC 103, and that applicants have established that the present application and Botros ‘512 were, at the time the present invention was made, commonly owned, Botros ‘512 is disqualified as prior art against the present claims.

Botros '789 discloses ink composition comprising ethoxylated polyethyleneimine, ammonium salt, i.e. electrolyte, dimethylethanolamine, surfactant, biocide, lower aliphatic alcohol, and water. However, there is no disclosure or suggestion in Botros '789 of thickening additive or viscosity and thus, no disclosure or suggestion of the use of 0.5-1% thickening additive to provide viscosity ranging from about 50 cP to about 1000 cP as required in all the present claims. Further, there is no explicit disclosure in Botros '789 of the pH of the ink with the exception of the examples which all disclose pH outside the scope of the present claims with the exception of example XI which discloses ink with pH of 9.06. However, while this example discloses ink possessing pH as presently claimed, the composition of example XI contains 0.8% dimethylethanolamine and 10% electrolyte wherein each amount is outside the scope of the present claims which require 1-3% pH modifier and 0.5-5% electrolyte. Further, the composition of example XI contains no water or thickening additive as presently claimed. Additionally, it is noted that Botros '789 is drawn to ink composition in contrast to present claims which are drawn to coating composition for application on an ink jet printable porous substrate prior to imaging the substrate for improving the waterfastness of the ink jet image.

Bates et al. disclose ink comprising water, 0.01-10% ethoxylated polyethyleneimine, ammonium sulfate, biocide, surfactant, alcohol, and dimethylethanolamine. It is disclosed that the pH of the ink is greater than 7. However, there is no disclosure or suggestion of the amount of pH modifier, i.e. dimethylethanolamine, utilized and no disclosure or suggestion of thickening additive as required in all the present claims. Further, the examples of Bates et al. disclose that the ink possesses viscosity of approximately 1-3 cP which is in direct contrast to the present claims which require composition with viscosity ranging from about 50 cP to about 1000 cP.

Further, it is noted that Bates et al. is drawn to ink composition in contrast to present claims which are drawn to coating composition for application on an ink jet printable porous substrate prior to imaging the substrate for improving the waterfastness of the ink jet image.

Thus, it is clear that Botros '789 and Bates et al., either alone or in combination, do not disclose or suggest the present invention.

Further, applicants' amendment filed 6/20/05 overcomes the 35 USC 112, second paragraph rejection of record.

In light of the above, the present claims are passed to issue.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 571-272-1123. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Callie E. Shosho
Primary Examiner
Art Unit 1714

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9/9/05